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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,380	03/22/2001	Mark J. Hampden-Smith	41890-01470	3937

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EXAMINER

HAILEY, PATRICIA L

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 09/09/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

AS 12

Office Action Summary

Application No.

09/815,380

Applicant(s)

HAMPDEN-SMITH ET AL.

Examiner

Patricia L. Hailey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23, 29-35, 37, 38, 41-46, 82 and 83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-23 and 83 is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-16, 29-35, 37, 38, 41-46, and 82 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Applicants' remarks and amendments, filed on June 18, 2003, have been carefully considered.

Claims 24-28, 36, 39, 40, and 47-87 have been canceled, and new claims 82 and 83 have been added.

Claims 1-23, 29-35, 37, 38, 41-46, 82, and 83 are now pending in this application.

Support for new claims 82 and 83 can be found in the Specification at page 18, lines 14-17.

The provisional rejection of claims 24-28 as claiming the same invention as that of claims 24-28 of copending Application Serial No. 09/532,917 has been withdrawn in view of the cancellation of these claims.

The 101 and the 102(e) rejections of claims 29, 30, 41, and 44 as claiming the same invention as that of claims 1-3, 20-22 and 39-41 of U. S. Patent No. 6,165,247 have been withdrawn in view of Applicants' amendment to claim 29 by incorporating therein the subject matter of claim 36.

The 102(b)/103(a) rejections of claims 1-5 and 9-16 as being anticipated by or, in the alternative, as obvious over Itoh et al. (U. S. Patent No. 5,876,867) have each been withdrawn in view of Applicants' persuasive arguments regarding this reference.

The 103(a) rejections of claim 17-23 as obvious over Itoh et al. and of claims 29-46 as obvious over Kudas et al. have both been withdrawn in view of Applicants' persuasive arguments regarding these rejections.

New Ground(s) of Rejection

The following New Grounds of Rejection are being made in view of the Examiner's reconsideration of the claims pending in this application (including the addition of new claims 82 and 83), and in view of the Examiner's reconsideration of the claims pending in Application Serial No. 09/532,917.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Double Patenting under 35 U.S.C. 101

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 41-46 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 41-46 of copending Application No. 09/532,917. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 41-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the last line of claim 41, the phrase "said support phase" lacks antecedent basis.

Double Patenting

5. Claims 1-3, 6-16, 29-35, 37, and 38 stand, and new claim 82 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 7-16, 29-31, 33-35, 37, and 38 of copending Application No. 09/532,917.

6. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '917 application specifies that the claimed powder batch comprises a "metal oxide active

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species phase”, in claim 1, whereas claim 1 of the instant application only recites an “active species phase”, yet claim 6 of the instant application recites that said phase is a “metal oxide”. Additionally, claim 29 of the ‘917 application specifically recites a step of heating an aerosol of droplets by passing the droplets through a heating zone, whereas claim 29 of the instant application merely recites the heating of the droplets. The claims of the instant application are considered to encompass the claims of the ‘917 application.

With respect to new claim 82, the subject matter therein – the recitation that the claimed electrocatalyst particles have an average particle size of not greater than about 20 μm – encompasses the subject matter of claim 12 of the ‘917 application (“an average particle size of not greater than about 10 μm ”).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

7. Claims 4 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 17-23 and 83 are allowed.

9. The following is a statement of reasons for the indication of allowable subject matter:

The prior art cited does not teach or reasonably suggest the limitations of claims 4, 5, or 17-23.

Conclusion

10. Applicant's amendments (including the addition of new claims 82 and 83) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

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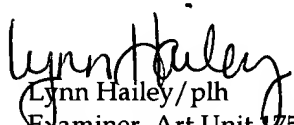
See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (703) 308-3317. The examiner can normally be reached on Mondays-Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on (703) 308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0661.


Lynn Hailey/plh
Examiner, Art Unit 1755
September 2, 2003


Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700